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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,889	06/25/2003	Hiroki Kobayashi	R2184.0239/P239	2305
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DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			EXAMINER NEWAY, SAMUEL G	
			ART UNIT	PAPER NUMBER
			2626	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/602,889	Applicant(s) KOBAYASHI, HIROKI	
	Examiner SAMUEL G. NEWAY	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6, 14 and 18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 6 is/are allowed.
- 6) ☒ Claim(s) 5, 14, and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is responsive to the amendment after non-final filed on 20 June 2008.
2. Claims 4 – 6, 14, and 18 are pending and considered below.

Response to Amendment

3. The Claim Objections are withdrawn in view of Applicant's amendments.
4. The Claim Rejections under 35 USC § 112 are withdrawn in view of Applicant's amendments.
5. Upon further consideration, claims 14 and 18 are rejected under 35 USC § 101 as shown herein below.

Response to Arguments

6. Applicant's arguments filed 20 June 2008 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., producing an installation program based on acquired print setting information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the arguments regarding claim 4 do not apply to claims to broader claims 5, 14, and 18.

Claim Objections

7. Claims 4, 5, and 14 are objected to because of the following informalities:

Claims 4 and 14 recite the limitation “incorporating acquired data” which the Examiner believes should be and is interpreted as ‘incorporating acquired print setting information’. Claim 5 recites “said computer” in the last line which should be ‘said computers’ in order for the limitation to have antecedent basis.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 14 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In claims 14 and 18, a “computer” is recited; however, it appears that the system would reasonably be interpreted by one of ordinary skill in the art as software, per se. The only elements recited as part of the system, elements configured to perform certain steps, are not explicitly and deliberately defined in the specification, and it appears that such would reasonably be interpreted as representative of the program code which causes software installation to occur.

Program code is functional descriptive material and therefore non-statutory, absent being claimed in combination with the necessary hardware to enable the software to act as a computer component and realize its functionality.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 5, 14, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Machida (US PGPub 2002/0083131).

Claim 5:

Machida discloses a software-installing method for installing a plurality of items of software computers and simultaneously performing initial print setup in said computers, so as to use a plurality of printing devices connected the computers through a network (see [0004] and [0012]), the method comprising the steps of:

producing a template of a scenario (driver setup information), the scenario being a file describing procedures for installing the software, the template including parameters, and providing said template to each of said computers (Fig. 19, steps s1902, s1903, and related text);

acquiring data corresponding to the parameters from an installation database (Fig. 19, step s1906 and related text) located outside said computers (“register property information at an installation server device , [0058]”), and wherein said data includes print setting information ([0095]); and

and producing scenarios, specific to each of said computers, based on the produced template (FIG. 19, step s1906); and

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inputting the produced scenario to installation programs (FIG. 19, steps 1907).

Claim 14:

Machida discloses a computer (Fig. 20, item 385 and related text), comprising:

a first element configured to acquire a template (driver for which property information is requested) of a scenario, the template including parameters representing incomplete information (Fig. 16 and related text);

a second element configured to read the template to determine whether the template contains one or more parameters representing incomplete information (Fig. 7, step s601 and related text), and subsequently acquiring print setting information corresponding to the one or more parameters by searching an installation database (Fig. 7, step s605 and related text), the installation database being located outside of said computer ("register property information at an installation server device", [0058]), wherein said searching is processed by said computer, based on said computer or a user of said computer ("driver information structure includes a PC name, ..., a user name, ...", [0052], FIG. 3 and related text);

a producing element configured to produce the scenario which is specific to said computer by incorporating the acquired print setting information into at least one or more parameters of said template ("update the driver in accordance with the acquired property information", [0073] and FIG. 7, step s607); and

inputting the produced scenario to an installation program; and an installing element configured to install said installation program and said print setting information into said computer (installation is inherent in updating of the driver which is saved, i.e. installed, including the added property information).

Claim 18:

Machida discloses a computer comprising:

a first producing element configured to produce a template of a scenario, the scenario being a file describing procedures for installing software, the template including parameters representing incomplete print setting information, and to provide said template to other computers (Fig. 19, step s1902 and related text); and

a second producing element configured to produce scenarios, specific to each of said computers, based on the produced template, by providing data for said parameters (Fig. 19, step s1906 and related text).

Allowable Subject Matter

11. Claims 4 and 6 are allowed.

12. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

13. The following is an examiner's statement of reasons for allowance: the prior art of record, individually or in combination, does not disclose acquiring a template of a scenario, the scenario being a file describing procedures for

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installing the software, and the template including one or more parameters representing incomplete information; reading the template to determine whether the template contains one or more parameters representing incomplete information, and subsequently acquiring print setting information corresponding to the one or more parameters by searching an installation database, the installation database being located outside of said computer, wherein said searching is processed by said computer, based on said computer or a user of said computer; producing the scenario which is specific to said computer by incorporating the acquired print setting information into at least one of the one or more parameters of said template; inputting the produced scenario to an installation program; and installing said installation program and said print setting information into said computer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL G. NEWAY whose telephone number is (571)270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R Hudspeth/
Supervisory Patent Examiner, Art Unit 2626

/S. G. N./
Examiner, Art Unit 2626